

## REMARKS

Favorable consideration and allowance are respectfully requested for claims 41-54 and 56-79 in view of the foregoing amendments and the following remarks. Claims 41-69 stand rejected. Claims 70-79 were subject to a restriction requirement and withdrawn from consideration.

Applicant's respectfully request reconsideration of the withdrawal of claims 70-79, it being submitted that the subject matter of the withdrawn claims would not present an undue burden to search.

### **35 U.S.C. §103 Rejections**

The rejection of claims 41-46, 48-58, 62, 63, 65, and 69 under 35 U.S.C. § 103 over U.S. Patent No. 5,249,801 ("Jarvis"), in view of U.S. Patent No. 5,239,165 ("Novak") and U.S. Patent 6,602,138 ("Nulph") is respectfully traversed.

Claim 41, 54, and 69 are amended to make clear that each pick represents a plurality of randomly generated numbers. Dependent claim 55, which previously recited this feature, is cancelled. These amendments do not present any new matter or introduce new features that were not previously presented.

The claims are directed to an inventive feature whereby with a written mark on a ticket a player identifies both (i) that a player wishes to play a plurality of "quick picks" or sets of computer generated numbers; and (ii) the particular quantity of quick picks that player wishes to play. Thus, with a single mark, the player can cause the game system to generate, 2, 3, 4, or even more, "picks" or sets of computer generated numbers. In the claim, each "pick" includes a set of numbers for a game entry.

This is made clear by the following language, excerpted from claim 41:

**reading a random request region** corresponding to a single game from the gaming slip, the random request region configured to be read by the scanner and **having a player's written mark** made with a writing instrument, **the written mark indicating the player's request for a plurality of randomly generated picks in the single game, each pick including a plurality of randomly generated numbers;** and

responsive to reading the random request region, generating the requested plurality of randomly generated picks for the single game, the quantity of picks generated for the single game being determined based on information read from the random request region and indicated by the player's written mark

Claim 54 includes similar language as shown in the following excerpt:

the random request region corresponding to the single game is configured to enable a player to request a plurality of computer generated picks for the single game by writing in the marking area with a writing instrument, each pick including a plurality of randomly generated numbers,

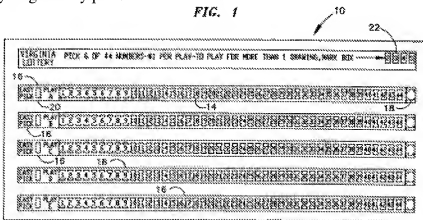
and wherein the random request region corresponding to the single game is configured so that the quantity of computer-generated picks for the single game is indicated by the writing made in the marking area by the player with the writing instrument

In each instance, the player's written mark indicates both (i) that a player wishes to select a plurality of "computer generated picks"; and (ii) the particular quantity of picks that player wishes to play.

None of the prior art references teaches a game, method, or ticket that allows a player to provide a written mark to both (i) select a plurality of "computer generated picks"; and (ii) the particular quantity of picks that player wishes to play.

The primary reference, Jarvis, describes a method where a player must make a separate mark for every single "easy pick."

FIG. 1



The Office Action indicates that Jarvis “fails to disclose that a plurality of quick picks may be selected for a single game”, see page 3 of the Office Action. In Figure 1, the player would have to mark more than one box on the left side of the ticket to play more than one pick. Jarvis contemplates a play slip including a region allowing a player to request exactly one “easy pick” for each written mark. Nothing in Jarvis teaches or suggests “the quantity of picks generated for the single game being determined based on information read from the random request region and indicated by the player’s written mark”, as recited in claim 41 and the corresponding language in claim 54.

Similarly, the secondary reference, Novak does not describe a method where a player might indicate a plurality of computer generated picks by a written mark.

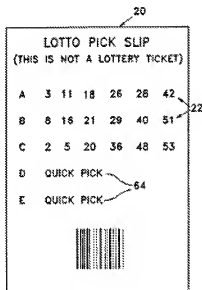


Fig. 4

As shown in Novak’s Figure 4, the pick slip provides for two separate quick pick entries, however, Novak provides no teaching of a method that involves a written mark to indicate a plurality of quick picks. Instead, Novak is directed to a method involving an electronic stand to allow a player to select numbers, rather than being based on a gaming entry slip as contemplated in the present claims. In Novak, a player does not mark a game slip; instead, a player picks numbers by operating a keyboard on an electronic pick stand. The electronic pick stand is shown

in Novak's Figure 3. Novak provides no teach or suggestion of a system or method as contemplated in the pending claims.

As pointed out by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 SCT 1727, 82 USPQ2d 1385, 1396 (U.S. 2007):

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. (Quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006) with approval).

Although an explicit teaching, suggestion or motivation need not be found in the cited references, to properly reject for obviousness, it is nevertheless necessary for the Examiner to articulate a convincing rationale as to what would lead a person skilled in the art to depart from the teachings of the prior art and strike out in the new direction claimed by applicants as their invention.

The Office Action does not explain what would cause the skilled artisan to disregard the express teachings of Jarvis and instead strike out in a new direction, modifying Jarvis in a way that would cause the skilled artisan to arrive at the presently contemplated invention. To arrive at the claimed invention, among other things, Jarvis would have to be modified not only to allow for a plurality of quick picks to be selected for a single game, but also to provide for the quantity of picks generated for the single game to be determined based on information that is (i) read from the random request region and (ii) indicated by a written mark provided by a player. These modifications to Jarvis are substantial and there is nothing, on the present record, to explain why a skilled artisan would undertake them. The Office Action essentially offers the conclusory assertion that it would have been obvious to modify Jarvis to arrive at the claimed invention. The question of obviousness cannot be properly resolved by a simple conclusion that the features that cannot be found in the prior would have been obvious. This is particularly true where, as in the present case, the features missing from the prior art represent multiple and significant differences from the prior art.

The cited references pointedly fail to teach or suggest all of the features of the claim. Further, the Office Action does not articulate why one might still arrive at the claimed invention

despite these differences between the claims and the prior art. As a result, it follows that a proper, prima facie case of obviousness has not been made out, and the rejection should be withdrawn.

The rejection of claims 47, 66, and 67 under 35 U.S.C. § 103(a), over Jarvis and Novak, in view of U.S. Patent No. 5,110,129 (“Alvarez”) and Nulph, is respectfully traversed. Claims 47, 66, 67 are patentable over the proposed combination of Jarvis, Novak, and Alvarez for at least the reasons presented below.

Claim 47 depends from claims 41 and claims 66 and 67 depend from claim 54. As explained above, the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of independent claims 41 and 54, as presented. Alvarez does not make up for the deficiencies of these references when compared against the independent claims. Accordingly, these dependent claims are allowable for at least the same reasons as the independent claims.

The rejection of claims 59-61 and 64 under 35 U.S.C. § 103(a), over Jarvis and Novak, in view of U.S. Patent No. 5,979,894 (“Alexoff”) and in further view of Nulph, is respectfully traversed. Claims 59-61 and 64 are patentable over the proposed combination of Jarvis,

Claims 59-61 and 64 depend from claim 54. As explained above, the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of independent claim 54, as presented. Alexoff does not make up for the deficiencies of these references when compared against the independent claims. Accordingly, these dependent claims are allowable for at least the same reasons as the independent claims.

**CONCLUSION**

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Although this paper is believed to be timely filed, if necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 50-3211 (Docket No. 21204.0171US).

Respectfully submitted,

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